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U.S. PTO Customer No. 25280

Case No.: 5127

DEC 29 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Francis et al.

Serial Number: 09/875,487

Filed: June 6, 2001

For: **INTERNET BASED FLOOR COVERING DESIGN REVIEW SYSTEM**

Group Art Unit: 3629
Examiner: Smith, Traci L.

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

<p align="center">CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. § 1.6(d)</p> <p>I hereby certify that this correspondence, and all correspondence referenced herein as being enclosed with this correspondence, is being transmitted by facsimile to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, at (571) 273-8300 on: Date: <u>12/29/05</u></p> <p>Signature: <u>Heidi M. Lewis</u></p> <p>Name: <u>Heidi M. Lewis</u></p>
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Sir:

APPEAL BRIEF

The claims of the above referenced application were the subject of a final rejection, in the Office Action dated May 31, 2005. A Notice of Appeal for the above referenced application was filed on September 29, 2005. Enclosed herewith is a brief in support of Appellant's position (Appeal Brief). A petition for a 1 month extension of time and an Amendment was submitted on December 28, 2005. The Commissioner is hereby authorized to withdraw any fees required for submission of this Appeal Brief from our Deposit Account No. 04-0500.

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I. REAL PARTY IN INTEREST

The above referenced application is the subject of an assignment to Milliken & Company, located in Spartanburg, S.C., which is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any related appeals or interferences that may directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

The above referenced application contains claims 1-33. Currently, only claims 15-33 are pending. An amendment to the claims under 37 USC 1.116(b)(2), wherein the claims (in particular, claims 22, 26, 27, 31, 32, and 33) were presented in better form for consideration on appeal, was filed December 28, 2005. Claims 22, 26, 27, 31, 32, and 33 were amended to correct antecedent basis. Claims 1-15 have been cancelled without prejudice or disclaimer. A listing of the pending claims is found in Appendix VIII.

IV. STATUS OF AMENDMENTS

Claims 22, 26, 27, and 31-33 have been amended since the Final Rejection dated May 31, 2005 to provide proper antecedent basis and consistency. Applicants respectfully request entry of the December 28, 2005 Amendment and consideration on appeal of the amended claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

This invention relates to a system and method for the interactive evaluation and/or marketing of proposed surface covering, wall covering or floor covering designs, patterns, colors, etc., whereby a number of pre-qualified users, associates, or subscribers such as architectural and design professionals may review designs for such products and provide early feedback to the manufacturer of such products as to the desirability of such designs to permit the manufacturer to thereafter concentrate subsequent marketing efforts on those designs of greatest interest to , for example, the commercial purchasing community. Focused marketing efforts thereafter are directed

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to those designs indicated as being most likely to experience broad based acceptance. Also, users, associates, or subscribers may order samples and/or products at any time during the survey.

Independent claims 15, 22, and 27 relate to an interactive computer based system and method for review of product designs, patterns and/or colors comprising a computer controlled internet-based interactive communications site for electronically communicating to a multiplicity of pre-qualified associates or subscribers one or more product designs in conjunction with a ballot style rating scale. The rating scale includes a plurality of selectable response menu items indicating varying levels of likelihood of use of the one or more product designs wherein only a single menu item may be selected for each design. A single rating selection may be made by each of said subscribers and transmitted back to the Web site for each of said one or more product designs whereby the likelihood of use of said one or more product designs may be estimated. The system further comprises a means for said subscribers to enter individualized comments concerning said one or more product designs and an interactive electronic shopping cart accessible by said associates or subscribers for ordering physical samples and/or products incorporating said one or more product designs. The interactive shopping cart is accessible by a link from a web document displaying both a product design and said selectable response menu items as initially communicated to subscribers, such that the shopping cart is accessible directly from said web document independent of selecting any given response menu item.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 15-33 Are Rejected Under 35 U.S.C. 103(a) as Being Unpatentable Over Thomas (US Patent Publication 2002/0002482) In View Of Sandus et al. (US Patent Publication 2002/0072993).

VII. ARGUMENT

A. Claims 15-33 Are Patentable Over the Thomas (US Patent Publication 2002/0002482) and Sandus et al. (US Patent Publication 2002/0072993) References.

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i) Claims 15-33

Thomas is directed towards a survey system that selects participants, conducts the survey over the electronic network, and incorporates multimedia into the surveys. Sandus et al. is not directed to an electronic survey over a network, but is directed to an on-line market (sales) system (not an on-line survey system). Thomas and Sandus et al. are directed to different technologies and solve different problems making Thomas and Sandus et al nonanalogous art. One conducting or designing on-line surveys (such as Thomas) would not look to on-line sales technologies. It is the present application and invention which combine on-line evaluation and ordering of samples and/or products.

Appellants respectfully note that by incorporating an independent product and/or sample ordering feature in the present invention, the chance of obtaining answers to the survey questions may be reduced. As best understood, surveys are traditionally designed to maximize the number of responses. Thus, any modification of the prior art, for example, Thomas, to incorporate an independent order feature appears to be contrary to such practices. One could argue that Thomas teaches away from ordering products and that modifying Thomas in light of Sandus et al. would change the operation of the invention of Thomas. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In order to establish a *prima facie* case of obviousness there must be some suggestion or motivation in the references that would lead to the combination thereof to reach the claimed invention. There is no motivation in Thomas to suggest the combination of the Sandus et al. and Thomas publications. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

For example, there is no teaching or suggestion in Thomas that there is a need to have a capability to allow the participant to order samples and/or products at anytime

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during the survey (as stated in pending independent claims 15, 22, and 27, "the shopping cart is accessible directly from said web document independent of selecting any given response menu item.") Further, there is no suggestion or motivation in Thomas to use the wallet system disclosed in Sandus et al. or any other means for ordering samples or products at any time in the survey system of Thomas. The Office Action admits that Thomas fails to teach the use of an online shopping cart available at any point in the process. Also, there is no teaching, suggestion, or motive in Sandus et al. to use a survey over the electronic network in the virtual business system.

The only teaching, suggestion, or motivation for such combination and modifications appear to come from Appellants' own disclosure. Only by hindsight use of the present invention is this combination suggested. It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The Office Actions's conclusion appears to be supported on grounds of what one of skill in the art could have done rather than on what the skilled person would have been motivated to do.

As noted at MPEP §2142, to reach a proper determination under 35 U.S.C. 103, the Examiner must step back in time and into the shoes worn by a person of ordinary skill in the art when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination of whether or not the claimed invention as a whole would have been obvious at that time to that person. Impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. Certainly, Applicants recognize that any judgment of obviousness is in some sense necessarily a reconstruction based on hindsight reasoning. However, such reconstruction may take into account only knowledge that was within the level of ordinary skill in the art at the time the claimed invention was made. See, MPEP §2145(X)(A).

The ultimate determination of patentability must take into account the entire record. The decision is based on the legal standard of "a preponderance of evidence." With regard to rejections under 35 U.S.C. 103, the Examiner must provide evidence which as a whole shows that the legal determination of obviousness is more probable

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than not. See, MPEP §2142. Thus, the essential query centers on what a person of skill in the art having the benefit of the cited references but without the benefit of the present application would have considered obvious at the time the invention was made. If the preponderance of the evidence does not weigh in favor of finding that the claimed invention would have been obvious to such a person, then the rejection cannot be maintained.

Additionally, all the claim limitations must be taught or suggested by the prior art as stated in MPEP § 2142. For the sake of argument, even if the Thomas and the Sandus et al. publications were combined, Appellants respectfully submit that this standard is not met with regard to the claims as now presented. For example, neither the Thomas nor the Sandus et al. publications, together or singly, teach or suggest the shopping cart of Appellants' claims 15, 22, and 27. Appellants respectfully disagree that the electronic wallet of Sandus et al. is equivalent to the shopping cart of the instant claims. An electronic wallet is a means by which a customer stores addresses and payment information such that the customer does not have to fill out additional forms when purchasing products (pg. 2, paragraph 0016). Using a wallet requires a customer to download or install the product that includes the wallet software (pg. 2, paragraph 0017). In other words, the customer must set up the electronic wallet on his/her computer prior to use of the wallet. As contrasted to Sandus et al., the instant claims involve an interactive computer based system for the review and ordering of product designs. In accordance with the present invention, ordering of these products involves the use of an interactive shopping cart wherein the shopping cart is accessible by a link from a web document displaying the product design and the survey. The use of the present shopping cart does not require the subscriber to download or install any software. The shopping cart is accessed via the web server, which is a part of the manufacturer's web site (see Figure 1). The shopping cart does not reside on the subscriber's computer as is the case for an electronic wallet. Clearly, the electronic wallet of the Sandus et al. publication is not the shopping cart of the instant claims.

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ii) Claims 22-28 and 30-33

Further, as stated at MPEP §2116, "The materials on which a process is carried out must be accorded weight in determining the patentability of a process." *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974). In this case, carrying out the process on surface covering, wall covering, or floor covering designs is part of the invention as a whole with respect to at least claims 22-28 and 30-33. As noted at MPEP §2141.02, the claimed invention as a whole must be considered. In this regard, there appears to be no contemplation in the cited art, taken singly or together, of communicating surface covering, wall covering or floor covering designs, such as, complex floor covering pattern elements for review, comment, and ordering.

iii) Claims 17, 23, 28-31, 33

With respect to, for example, pending claims 17, 23, 28, 29, 30, 31, and 33, the subscribers (or associates) are professionals within the architectural and design communities (for example such professionals that make carpet or flooring decisions). The Office Action admits that Thomas does not explicitly teach the survey participants being in the architectural and design communities. The addition of the Sandus et al. publication does not cure this deficiency in that the Sandus et al. publication does not appear to address architectural and design professionals; surface covering, wall covering, or floor covering designs; and combinations thereof.

iv) Claims 28,30,31,33

With respect to, for example, pending claims 28, 30, 31, and 33, the professionals review the floor covering, surface covering, or wall covering designs before such designs are released for purchase or prior to such designs being marketed on a broad basis. The Office Action admits that Thomas does not explicitly teach using information for promoting products and Appellants believe that Sandus et al. also does not teach professionals reviewing floor covering, surface covering, or wall covering designs before such designs are released for purchase.

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v) Claims 22-27 and 30-33

With respect to, for example, claims 22-27 and 30-33, at least in the alternative, floor covering designs are evaluated and floor covering samples and/or products may be ordered. The Office Action admits that Thomas fails to teach viewing products in several different designs before purchase, and the Office Action admits that Thomas and Sandus et al. do not explicitly teach the products described in claims 30 and 33 (i.e. surface covering, wall covering, or floor covering designs, patterns, or colors.)

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Conclusion

For the above reasons, Appellant respectfully requests the Appeal Board to reverse the decision of the Examiner and to allow claims 15-33. In the event that there are additional fees associated with the submission of these papers, Appellants hereby authorizes the Commissioner to withdraw those fees from our Deposit Account No. 04-0500. Also, in the event that additional time is required to have the papers submitted herewith to be considered timely, Appellants hereby petition for any additional time required to make these papers timely and authorization is hereby granted to withdraw any additional fees necessary for this additional time from our Deposit Account No. 04-0500.

December 29, 2005

Respectfully submitted,

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VIII. CLAIMS APPENDIX (as per the Amendment filed December 28, 2005)

Claims 1-14 (Cancelled)

15. (Previously presented): An interactive computer based system for review of product designs, patterns and/or colors comprising a computer controlled internet-based interactive communications site for electronically communicating to a multiplicity of pre-qualified subscribers one or more product designs in conjunction with a ballot style rating scale including a plurality of selectable response menu items indicating varying levels of likelihood of use of said one or more product designs wherein only a single menu item may be selected for each design such that a single rating selection may be made by each of said subscribers and transmitted back to the Web site for each of said one or more product designs whereby the likelihood of use of said one or more product designs may be estimated, the system further comprising means for said subscribers to enter individualized comments concerning said one or more product designs and an interactive electronic shopping cart accessible by said subscribers for ordering physical samples and/or products incorporating said one or more product designs wherein the interactive shopping cart is accessible by a link from a web document displaying both a product design and said selectable response menu items as initially communicated to subscribers, such that the shopping cart is accessible directly from said web document independent of selecting any given response menu item.

16. (Original): The system as recited in claim 15, wherein said system includes a

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computer based program for tabulating and storing responses from said subscribers.

17. (Original): The system as recited in claim 15, wherein said subscribers are selected from the group consisting of professionals within the architectural and design communities.

18. (Original): The system as recited in claim 15, including an alert system for alerting said subscribers when new product designs are available for review.

19. (Original): The system as recited in claim 18, wherein said alert system comprises an e-mail delivery system.

20. (Original): The system as recited in claim 15, wherein said one or more product designs are electronically communicated as printable web documents to computers operated by said subscribers.

21. (Original): The system as recited in claim 20, wherein said printable web documents include embedded print commands activatable by said subscribers.

22. (Currently Amended): A method of evaluating the potential market acceptance of one or more floor covering designs with the assistance of pre-qualified associates, the method comprising:

electronically communicating to a multiplicity of pre-qualified associates an interactive web document displaying one or more floor covering designs in combination

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with a standardized rating scale comprising a plurality of selectable responses indicating varying levels of likelihood of use of said one or more floor covering designs and wherein said web document further includes a link from the web document as initially communicated to ~~subscribers~~ associates to an interactive electronic shopping cart accessible by said ~~subscribers~~ associates for ordering physical samples and/or products incorporating designs as displayed on the web document, such that the shopping cart is accessible directly from said page independent of selecting any given response menu item ;

electronically receiving from at least a portion of said associates their selected responses indicating the likelihood of use of said one or more floor covering designs and/or any orders placed; and

tabulating and archiving the selected responses received from said associates.

23. (Original): The method as recited in claim 22, wherein said associates are selected from the group consisting of professionals within the architectural and design communities.

24. (Original): The method as recited in claim 22, wherein the electronically communicating and electronically receiving steps are carried out over the internet.

25. (Original): The method as recited in claim 24, wherein said one or more floor covering designs are electronically communicated to computers operated by said associates in the form of printable web documents.

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26. (Currently Amended): The system as recited in claim 25, wherein said printable web documents include embedded print commands activatable by said subscribers associates.

27. (Currently Amended): A method of evaluating the potential market acceptance of one or more floor covering designs with the assistance of pre-qualified associates, the method comprising:

providing an interactive web site for the communication and receipt of data via the internet;

electronically communicating to a multiplicity of pre-qualified associates web documents illustrating one or more floor covering designs in combination with a standardized rating scale comprising a plurality of selectable responses indicating varying levels of likelihood of use of said one or more floor covering designs and wherein at least a portion of said web documents further include links from the web documents as initially communicated to ~~subscribers~~ associates to an interactive electronic shopping cart accessible by said ~~subscribers~~ associates for ordering physical samples and/or products incorporating designs as displayed on the web documents, such that the shopping cart is accessible directly from said web documents independent of selecting any given response menu item;

electronically receiving from at least a portion of said associates responses indicating the likelihood of use of said one or more floor covering designs and/or orders placed; and

tabulating and archiving the selected responses received from said associates, wherein the electronically communicating and electronically receiving steps are

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conducted through said interactive web site.

28. (Previously presented) The system as recited in claim 17, wherein said system permits said professionals to immediately communicate back to a manufacturer of floor covering material an indication as to the likely commercial potential for such designs prior to such designs being marketed on a broad basis, said professionals may also acquire samples and order products incorporating the various designs for review, and the information retrieved from said professionals may thereafter be utilized by the manufacturer to promote those designs which are identified by said professionals as being most desirable.

29. (Previously presented) The system as recited in claim 17, wherein said subscribers may review designs for such products and provide early feedback to a manufacturer of such products as to the desirability of such designs so as to permit the manufacturer to thereafter concentrate subsequent marketing efforts on those designs of greatest interest to the commercial purchasing community and focused marketing efforts thereafter are directed to those designs indicated as being most likely to experience broad based acceptance.

30. (Previously presented) The system as recited in claim 17, wherein said professionals review potential surface covering, wall covering or floor covering designs, patterns or colors before such designs are released for purchase.

31. (Currently Amended) The system as recited in claim ~~22~~ 23, wherein said system

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permits said professionals to immediately communicate back to a manufacturer of floor covering material an indication as to the likely commercial potential for such designs prior to such designs being marketed on a broad basis, said professionals may also acquire samples and order products incorporating the various designs for review, and the information retrieved from said professionals may thereafter be utilized by the manufacturer to promote those designs which are identified by said professionals as being most desirable.

32. (Currently Amended) The system as recited in claim 22, wherein said subscribers associates may review designs for such products and provide early feedback to a manufacturer of such products as to the desirability of such designs so as to permit the manufacturer to thereafter concentrate subsequent marketing efforts on those designs of greatest interest to the commercial purchasing community and focused marketing efforts thereafter are directed to those designs indicated as being most likely to experience broad based acceptance.

33. (Currently Amended) The system as recited in claim 22 23, wherein said professionals review potential surface covering, wall covering or floor covering designs, patterns or colors before such designs are released for purchase.

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IX. EVIDENCE APPENDIX

Applicant is not aware of any such evidence.

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X. RELATED PROCEEDINGS APPENDIX

Applicant is not aware of any such related proceedings.